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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,990	05/24/1999	STEPHEN M. MEGINNISS III		8550

24737 7590 06/27/2005

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EXAMINER

MATHEW, FENN C

ART UNIT PAPER NUMBER

3764

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/316,990
Filing Date: May 24, 1999
Appellant(s): MEGINNISS ET AL.

MAILED

JUN 27 2005

Group 3700

Clark A. Puntigam
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/21/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-5, 9, and 12-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,189,751	Giuliani	03-1993
5,040,260	Michaels	08-1991
5,987,688	Roberts	11-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliani (U.S. 5,189,751) in view of Michaels (U.S. 5,040,260), and further in view of Roberts (U.S. 5,987,688). This rejection is set forth in a prior Office Action, mailed on October 20, 2004.

(11) Response to Argument

Under the Argument section of the appeal brief filed, on page 3, paragraph 2, line 1, page 4, paragraph 3, lines 1-4, and page 5, paragraph 2, lines 1-5, Applicant has agreed that Giuliani as modified by Michaels and Roberts leads to the claimed structural limitations. Applicant's arguments are based on the fact that it would not be obvious to combine the above-cited references specifically for the problem of xerostomia. In response to applicant's argument that one of ordinary skill would not combine the references to solve the problem of xerostomia, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that one would not combine the above cited references to solve the problem of xerostomia, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3764

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Respectfully submitted,

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fcm
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June 20, 2005

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